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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/655,520	09/05/2000	Eli M. Noam		8435

7590 05/20/2004  
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EXAMINER

GARG, YOGESH C

ART UNIT PAPER NUMBER

3625

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/655,520

Applicant(s)

NOAM, ELI M.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

### **DETAILED ACTION**

1. Amendment A, paper #4 received on 1/12/2004 is acknowledged and entered. Claims 1-7 have been cancelled. New claims 8-17 have been added. Currently claims 8-17 are pending for examination.

### ***Response to Arguments***

2. Since the applicant has cancelled claims 1-7 the rejection of claims 1-7 under 35 USC § 101 & 112 are withdrawn.

Applicant's arguments with respect to claims 8-17 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-17 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter. Claims 8-17 are directed to disembodied data structure which are per se not statutory. C.f. In re Wamerdam. Independent claims 8, 10, and 12 claim "an electronic bit-string", a software control program", "dedicated fields", "storage media", and "software program", which all represent a data structure resembling a data file without reciting any functional changes due to an application

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program and resulting in an useful, concrete and tangible result. Functional descriptive material, in combination with a computer readable medium must be capable of producing a useful, concrete and tangible result when used in a computer system is statutory i.e., a set of instructions in combination with a computer system. C.f. *In re Wamerdam* - data structure stored in a computer memory, and *In re Lowery*, 32 USPQ2d 1031 (Fed. Cir. 1994) - data structure in a computer readable medium.

A claim to a computer readable medium encoded with functional descriptive material that can function with a computer to effect a practical application that results in a useful, concrete and tangible result (i.e. running an assembly line or executing a stock transaction) satisfies Section 101. Examples of Statutory Functional Descriptive Material are:

(a) A claimed computer-readable medium encoded with a functional data structure – this defines structural and functional relationships between the data structure and the hardware/software components. See *Wamerdam*.

(b) A claimed computer-readable medium encoded with a computer program - this defines structural and functional relationships between the computer program and the computer itself which allows the program's functionality to be realized provided that a useful, concrete and tangible result is realized. See U.S. Patent 5,710,578 to Beauregard et al.

Since claims 9, 11 and 13-17 are dependencies of claims 8, 10, and 12 they also inherit the same deficiency.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose the limitation “ the packet controller and/or the packet wallet including the access tokens consisting of several data packets, storable and machine readable on the storage media of data networks, that are associated with each other through identification in the convoy information field, for the purpose of enabling long programs to be broken up into several data packets” , in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 5.1. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim 15 recites the limitation, “ A system as in any one of

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claims 8, 10, and 12, further comprising a) the packet controller and/or the packet wallet including the access tokens consisting of several data packets, storable and machine readable on the storage media of data networks, that are associated with each other through identification in the convoy information field, for the purpose of enabling long programs to be broken up into several data packets". Claims 8, 10, and 12, recite that the packet controller and packet wallet are storable as part of a data packet then it is unclear as how can packet controller and packet wallet can consist of several data packets, as recited in claim 15.

5.2. Claim 15 recites the limitation " that are associated with each other through identification in the convoy information field, for the purpose of enabling long programs to be broken up into several data packets " and there is insufficient antecedent basis for this limitation in the claims 8, 10, and 12 of which it is a dependency.

6. Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

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***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 8-14 and 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Biffar (US Patent 6,047,269).

**Regarding claim 8**, Biffar teaches a system of payment for transactions, including but not limited to those involving information (see at least abstract), comprising:

a) an electronic bit-string known as an access token, denominated at a certain value, capable of containing the address of the issuer of said access token, and storable as part of a data packet on a computer readable medium (see at least col.5, line 65-col.6, line 34, " ... FIG. 1-A is a simplified block diagram of a digital voucher according to the invention. A digital voucher 1A consists, according to the invention, of an identifying element 10000 made up of identifying digits, and a dynamic log 20000 made up of log digits. The identifying element 10000 may include a set of digits representing a transferable value 11000 in an external system for

*which the voucher 1A can be redeemed,.....* ". Note: 11000, the transferable value corresponds to an electronic-bit-string denominated in a certain value and storable as a part of a data packet, where the digital voucher corresponds to the data packet);

b) a software control program known as a packet controller, similarly storable as part of said data packet (see at least col.5, line 65-col.6, line 34, " ... FIG. 1-A is a *simplified block diagram of a digital voucher according to the invention. A digital voucher 1A consists, according to the invention, of an identifying element 10000 made up of identifying digits, and a dynamic log 20000 made up of log digits. The identifying element 10000 may include a set of digits representing a transferable value 11000 in an external system for which the voucher 1A can be redeemed,.....* " .

Note: Dynamic log 20000 corresponds to a software control program storable as part of digital voucher which corresponds to the data packet, as claimed. In Biffar, the dynamic log enables to create and record histories of all the transactions. ) ;

c) dedicated fields in said data packet known as a transactional data packet, to store one or several said access tokens denoted in (a) above in a field known as a packet wallet, and to store said packet controller denoted in (b) above (see at least col.5, line 65-col.6, line 34, " ... FIG. 1-A is a *simplified block diagram of a digital voucher according to the invention. A digital voucher 1A consists, according to the invention, of an identifying element 10000 made up of identifying digits, and a dynamic log 20000 made up of log digits.... The identifying element 10000 may include a set of digits representing a transferable value 11000 in an external system for which the voucher 1A can be redeemed,...* . " . Note: The dedicated fields



represented by 11000 stores one or several transferable values which correspond to access tokens ) ;

d) Storage media for data packets at various nodes of a network, as common for Internet and other data transmission systems (see at least col.6, lines 35-67, " *FIG. 1-B is a block diagram of the self-contained payment system according to the present invention within which a voucher 1A (FIG. 1-A) is used. The system includes two major types of components, remote devices (programmed devices) such as remote device A 100 or remove device B 101 and a central system 200. A large number of remote devices such as remote device A 100 are linked to the central system 200. The linkage is through a network for internal signal transport 300. .... Both the network for internal signal transport 300 and the network for external signal transport 400 must be able to transport digital information such as, for example, the internet, cellular networks, telecommunication networks, cable networks, TV networks, LANs or any other kind of computer network.* " and col.7, line 45- col.8, line 46, " *FIG. 2 is a block diagram of a remote device. The remote device A 100 (FIGS. 1-B and 1-C) includes an input signal receiver 110, a processor 120, a memory 130, .....* ". Note: Remote devices A 100 and B101 correspond to nodes of a network and they consist a storage media in the form of a memory 130 to store data packets); and

e) a software program -- able to interact with said data packets denoted above as (c) through said packets' packet controller (b), with transactions transferring or receiving the said access tokens (a) which the said packets (c) carry-- located at the facilities and equipment of providers of various services involving information, data, and media content, and/or located at the facilities and equipment of the users of such information,

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and not limited to computer, data communication, or Internet equipment, known as a facility access gateway, and including a facility access controller and a facility wallet, all stored on a storage medium and computer readable (see at least col.7, line 45-col.8, line 46 which discloses that device A 100 is a programmed device including instruction to implement all the claimed functions such as transferring or receiving access tokens which refer to various transferable values in Biffar).

**Regarding claim 9**, Biffar discloses a method of using the system in claim 8 with access tokens, comprising:

a. placing access tokens after being acquired from an issuer, in a packet wallet by a source of said transactional data packets (see at least col.7, lines 43, which shows that a Central system corresponding to the issuer in the application transfer the transferable values, which correspond to the access tokens to a user's v digital voucher, which corresponds to the transactional data packets. Device A 100 corresponds to a source of said transactional data packet) ;

b. transferring said access tokens in full or part at the facility access gate into the facility wallet in return for access to the facility and its services, or in return for other consideration ;

c. transferring one or several access tokens from the facility wallet to the packet wallet in return for the service which the packet provides to the facility, or in return for other consideration; and

d. controlling said transfers by an interaction of the packet, such as through its packet controller, and the facility access.

(For the above b, c, and d see at least col.7, line 1-col.8, line 46 which discloses that device A 100 is a programmed device including instruction to implement all the claimed functions such as transferring access tokens among different facilities. Device A100 corresponds to the facility access gate which receives the access tokens from the central system 200 and transfers them into digital vouchers 1, 2, etc . The digital vouchers, as mentioned above correspond to the transaction data packets. As indicated above Dynamic log 20000 controls and records all the transactions involving transfers of access tokens relating to services rendered. The access tokens, as mentioned above correspond to transferable values in Biffar).

**Regarding claims 10-13**, their limitations are closely parallel and covered by the limitations of claims 8-9 and are therefore analyzed and rejected on the basis of same rationale as being anticipated by Biffar.

**Regarding claim 14**, Biffar teaches a system as in any one of Claims 8, 10, and 12, with the additional and severable features to enable additional types of performances, comprising:

a) a field on a transactional data packet, said field known as the convoy information field, or, for Claim 10, known as the convoy intelligent agent, with said convoy information field identifying other packets as its follower packets, in whose behalf it conducts transactions with facilities, said field to be storable and machine readable (see at least col.5, line 65-col6, line 34, *"A digital voucher 1A consists, according to the invention, of an identifying element 10000 made up of identifying digits, and a dynamic log 20000 made up of log digits. ....The data of the dynamic log 20000 is increased whenever there is a transaction involving the voucher 1A, wherein a transaction includes a creation, any use including inactivation and redemption, or movement of the voucher 1A. The log digits contain data describing the history of the transactions, 21000,22000,23000,24000,25000. These log digits can include a transaction code consisting of information such as the date and time of the transaction as well as the identification number of the device having performed the transaction. .... The identifying element 10000 and dynamic log 20000 can at any time be evaluated against a set of criteria to determine to which of several destinations the voucher will be transferred to in a next step. "* . Note: The log digits pertaining to the history of transactions 21000, 22000.....correspond to convoy information field); and

b) a stored software program as part of the facility access controller that reads the source and destination addresses and other fields of convoy and follower packets, and is able to establish access conditions for follower packets based on said information, with the aim of facilitating repetitive high speed transactions (see col6, lines 12-34, which teaches that a stored software program enables to detect all the

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transaction history and movement of digital voucher from one device to another device and this reads upon the claimed limitation. The devices correspond to different nodes on a network where the transferred values are either received or transferred in exchange of services/products. See also col.9, line 65-col.17, line 10).

**Regarding claim 16**, Biffar discloses that a system as defined in Claim 8 or Claim 10, further comprising:

Transactional data packets and/or additional packet controller software, as well as additional access tokens, subsequent to their being sent out initially, all storable on the storage media of data networks, and machine readable, for the purpose of enabling additional types of performance (see at least col.7, lines 1-30, which discloses creating of several digital vouchers 1,2, 3, 4, 5. It is already analyzed above that these digital vouchers correspond to transactional data packets and these packets are sent out to a number of nodes on Internet such as devices A100 or B 101 which are computer systems equipped with processor, memory and application programs to store and process transactions using these digital vouchers containing access tokens).

**Regarding claim 17**, Biffar discloses that a system as defined in Claim 8 or Claim 10, in which:

a) facility gateways could be located at a distance from the actual facility, and/or issue their own transactional data packets, all storable and machine readable on the storage media of data networks and other nodes (see col.6, line 35-col.8, line 46

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discloses that facility gateways which are part of remote devices A100 and B101 are remotely located from each other and issue their own digital vouchers, which correspond to transactional data packets and all of these are storable on computer readable memories) ; and

b) transactional data packets issued by various packet sources, and storable and machine readable on the storage media of data networks and other nodes, including those of facilities, which can transact among themselves while remote from their facilities, thereby enabling the creation of automatized markets for services and goods (see at least col.4, lines 44-col.5, line 28 which teaches the claimed limitation of enabling a creation of automatized market for services and goods).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US 2003/0061170 A1 to UZO discloses a method and an apparatus making electronic payments consisting of access tokens in order to provide unrestricted commerce on the Internet or similar network (see at least paragraphs 1-22 on pages 1-2

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

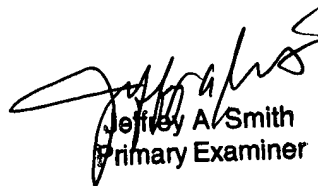
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Yogesh C Garg  
Examiner  
Art Unit 3625

YCG  
May 13 2004



Jeffrey A. Smith  
Primary Examiner